

REMARKS

Claims 1, 4-7, 10-13, 15, 18, 21-23, and 25-27 are pending.
Claims 1, 7, 15, and 18 are in independent form.

Rejections under 35 U.S.C. § 101

In the action mailed January 5, 2007, claim 1 was rejected under 35 U.S.C. § 101 as allegedly being directed to nonstatutory subject matter. As best understood by Applicant, the rejection contends that a system that includes a database and a logic design module is an abstract idea. See *Office action mailed January 5, 2007*, page 6, para. 9.1. The rejection also contends that a logic design module must actually perform operations to constitute patentable subject matter.

As a threshold matter, Applicant would like to point out that nothing requires the logic design module recited in claim 1 to be implemented exclusively as software, as appears to be contended in the rejection. For example, the logic design module can be implemented as hardware.

Turning to the rejection, the contention that a system is abstract solely because it potentially includes software defies logic. The Examiner is invited to consider the systems around him that potentially include software such as, e.g., motor vehicles, watches, cell-phones, and the like. A contention that these systems are abstract solely because they potentially include software is simply illogical. Moreover, to the best of

applicant's knowledge, no judicial exception to the indication in 35 U.S.C. § 101 that machines, manufactures, and improvements thereto constitute patentable subject matter has ever been made on the basis of potentially including software.

Also, the contention that a logic design module is an abstract idea is also without basis. Instead, a logic design module (even if implemented in software) produces concrete, useful, and tangible results, much like word processors or web browsers that are implemented in software. In particular, logic design modules produce logic designs. Logic designs have clear utility in designing logic—which is clearly a concrete, useful, and tangible result.

As for the contention that a logic design module must actually perform operations to constitute patentable subject matter, Applicant respectfully disagrees. The requirements of 35 U.S.C. § 101 simply do not require claims to recite the actual performance of operations. For example, claims directed to a hammer need not recite that the hammer is actually driving a nail. Claims directed to a car need not recite that the car is actually driving down the road. Similarly, applicant submits that claims to a logic design module need not recite that the logic design module is actually updating a logic design or indicating design discrepancies.

Accordingly, claim 1 and the claims dependent therefrom are directed to patentable subject matter. Applicant respectfully requests that the rejections of claim 1 and the claims dependent therefrom be withdrawn.

Claim 7 was rejected under 35 U.S.C. § 101 as allegedly being directed to nonstatutory subject matter. The rejection contends that updating computer code and indicating design discrepancies is not a tangible result.

Applicant respectfully disagrees. Members of an entire profession (i.e., computer programmers) spend their days updating computer code. Applicants submit that the fruits of their labor are tangible enough to meet the requirements of any judicial exception to 35 U.S.C. § 101. Similarly, design discrepancies prevent logic designs from operating as intended. Indicating such design discrepancies automatically is clearly a tangible result, since information needed for the proper operation of a logic design is a tangible result.

Accordingly, claim 7 and the claims dependent therefrom are directed to patentable subject matter. Applicant respectfully requests that the rejections of claim 7 and the claims dependent therefrom be withdrawn.

Claim 15 was rejected under 35 U.S.C. § 101 as allegedly being directed to nonstatutory subject matter. As best understood by Applicant, the rejection contends that an apparatus that includes a central database, modification logic, and an interface could potentially be non-statutory subject matter on the ground that the apparatus is able to "perform abstract operations, such as changing a bit width." See *Office action mailed January 5, 2007*, page 6, para. 9.3. The rejection is also understood to contend that the recited "modification logic" is non-statutory subject matter for not reciting a processor.

As a threshold matter, Applicant would like to point out that nothing requires the modification logic recited in claim 15 to be implemented exclusively as software, as appears to be contended in the rejection. For example, the modification logic can be implemented as hardware.

Turning to the rejection, the contention that a system is not patentable subject matter simply because it has the ability to perform abstract operations has never been recognized as an exception to the patentable subject matter defined under 35 U.S.C. § 101. Accordingly, the rejection is improper.

Moreover, the contention that "modification logic" is non-statutory subject matter for not reciting a processor is also without basis. As discussed above, nothing requires the modification logic recited in claim 15 to be implemented exclusively as software. Further, the mere fact that a claim recites logic absent a processor has never been recognized as an exception to the patentable subject matter defined under 35 U.S.C. § 101. Accordingly, the basis of the rejection is improper.

Accordingly, claim 15 and the claims dependent therefrom are directed to patentable subject matter. Applicant respectfully requests that the rejections of claim 15 and the claims dependent therefrom be withdrawn.

Claim 18 was rejected under 35 U.S.C. § 101 as allegedly being directed to nonstatutory subject matter. As best understood by Applicant, the rejection contends that the recited machine-accessible medium "appears to contain abstract operations." *See Office action mailed January 5, 2007, page 6, para. 9.4.* The rejection also contends that updating computer code and indicating design discrepancies is not a tangible result.

Applicant respectfully disagrees. As for the machine-accessible medium containing abstract operations, claim 18 recites a machine-accessible medium that contains instructions which cause a machine to perform operations. Machine-accessible media that contain instructions are clearly tangible and within the scope of 35 U.S.C. § 101.

As for the contention that updating computer code and indicating design discrepancies is not a tangible result, as discussed above, both of these activities are clearly tangible enough to meet the requirements of 35 U.S.C. § 101.

Accordingly, claim 18 and the claims dependent therefrom are directed to patentable subject matter. Applicant respectfully requests that the rejections of claim 15 and the claims dependent therefrom be withdrawn.

Rejections under 35 U.S.C. § 103

In the action mailed January 5, 2007, claims 1, 4-7, 10-13, 15, 18, 21-23, and 25-27 were rejected under 35 U.S.C. § 103 as obvious over U.S. Patent Publication No. 2002/0023250 to Yumoto et al. (hereinafter "Yumoto") in combination with other references.

Although applicant disagrees with the bases of these rejections, submitted herewith is a Declaration under the provisions of 37 C.F.R. § 1.131 in which the inventors assert conception and reduction to practice of the subject matter recited in claims 1, 4-7, 10-13, 15, 18, 21-23, and 25-27 before the June 8, 2001 filing date of Yumoto.


Accordingly, Yumoto is not prior art. Applicant respectfully requests that the rejections of claims 1, 4-7, 10-13, 15, 18, 21-23, and 25-27 be withdrawn.

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant asks that all claims be allowed. Please apply
the one-month extension of time fee and any other charges or
credits to Deposit Account No. 06-1050.

Respectfully submitted,

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